

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Moreh, et al.

Docket No: 60468.300301

Serial No: 09/827,697

Group Art Unit: 2155

Filing Date: April 7, 2001

Examiner: Sheikh, Ayaz

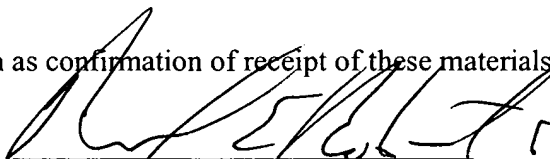
For: "FEDERATED AUTHENTICATION SERVICE"

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL

- ☒ Transmitted herewith is a Petition from an Action of the Examiner for this application.
- ☒ Applicant is
☒ a small entity.
☐ other than a small entity.
- ☒ Attached is a check in the sum of \$130.00.
☐ Charge Account No. 08-3240 the sum of \$ _____.
A duplicate of this transmittal is attached.
- ☒ In the event that: a) no check to cover the filing fee is enclosed, b) any above-referenced check is inadvertently omitted or lost, or c) any enclosed check is in an amount less than or greater than the required fee, the Commissioner is authorized to charge any required fees, additional fees, or credit any overpayment to Deposit Account 08-3240. A duplicate of this authorization is enclosed for that purpose.
- ☒ Attached is a postcard for date-stamped return as confirmation of receipt of these materials.


Date: August 31, 2004

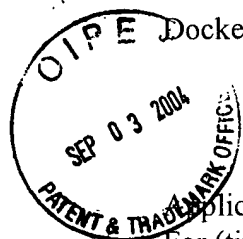

RAYMOND E. ROBERTS
Reg. No. 38,597

IPLO®
Intellectual Property Law Offices
1901 S. Bascom Avenue, Suite 660
Campbell, CA 95008
Telephone: (408) 558-9950
Facsimile: (408) 558-9960

CERTIFICATE OF MAILING (37 CFR 1.8(a))

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited on August 31, 2004, with the U.S. Postal Service as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313.
Date: August 31, 2004


Patricia Beilmann



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: **MOREH, et al.**
For (title): **FEDERATED AUTHENTICATION SERVICE**

Filing Date: **04/07/2001**
Serial No: **09/827,697**

Examiner: **TRAN, Phillip B.**
Art Unit: **2155**

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PETITION FROM AN ACTION OF THE EXAMINER
(37 C.F.R. 1.181)

Sir:

Petition (37 C.F.R. 1.181(a)(1)):

Applicant hereby petitions the Commissioner from an action of the Examiner in the *ex parte* prosecution of this application.

Please note: A PETITION FOR ACCELERATED EXAMINATION for this case was GRANTED on 12/10/2003, and we respectfully request that handling of this petition and all other prosecution of this case by the Office proceed accordingly.

Fee (37 C.F.R. 1.17(h) and 1.181(d)):

Enclosed please find a check for \$130.00 as appropriate payment for this petition. Applicant urges, however, that this petition is only necessary due to error on the part of the Office, and that this payment for petition should therefore appropriately be refunded.

The Commissioner is hereby authorized to charge any additional fees which may be required or to credit any overpayment of fees in this matter to deposit account number 08-3240.

Certificate Of Mailing Or Transmission (37 CFR 1.8)

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as first class mail addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 or facsimile transmitted to the U.S. Patent and Trademark Office at _____ on the date shown below.

AUG. 31, 2004
(date)

Patricia Beilmann
(Signature of PATRICIA BEILMANN)

Timeliness (37 C.F.R. 1.181(f)):

This petition is timely because it is being submitted within two months from the action being complained of, which occurs in an Action by the Office dated 07/22/2004.

Statement of facts (37 C.F.R. 1.181(b)):

A Notice of Appeal and an Appeal Brief were submitted in this case on 04/16/2004 and acknowledged as received by the Office on 04/19/2004.

In the Office Action dated 07/22/2004 the Examiner stated “*In view of the Appeal Brief filed on 4/19/2004, PROSECUTION IS HEREBY REOPENED.*” Respectfully, this is error because:

- [1] no proper ground for reopening the prosecution exists, and
- [2] proper procedure for reopening the prosecution apparently was not followed.

With respect to [1], whether a proper ground for reopening the prosecution exists, MPEP 1208.01 provides useful guidance:

There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. Id. at 1303, 190 USPQ at 427.

In the present case, the statutory basis for the rejections remains the same in all of the Action dated 07/22/2004 (paper 18), the prior (advisory) Action dated 02/17/2004 (paper 15), and the prior (office) Action dated 02/03/2004 (paper 13). That basis is 35 U.S.C. §§102(b) and 103(a).

The evidence relied upon in support of the rejection also remains the same in the noted Actions. That evidence is BARU et al., “The SDSC Storage Resource Broker,” ACM, 1998 (hereinafter “Baru”), portions of the application specification that the Examiner has mischaracterized “*admitted prior art*” (hereinafter “APA”), and Pat. App. Pub. No. US 2002/0120474.

And the discussion of, or rationale in support of, the rejection is essentially unchanged and cannot appropriately constitute a new ground of rejection. The Action dated 07/22/2004

differs from the Action dated 02/03/2004 only by the addition of clearly trivial parenthetical comments (e.g., “*providing client credentials on behalf of the subject (= ticket mechanism) [see Sec. 2.5 on Page 3]*” wherein underlining shows the addition); by clearly trivial changes to small portions of the text (e.g., “~~i.e.,~~ = proxy operations” wherein strikethrough shows the deletion); and by clearly trivial deletions (e.g., “*Baru further teaches ~~the system of claim 1, wherein the~~*”). Enclosed herewith as an Appendix is a “mark-up” copy showing all of the differences between relevant portions of the Action dated 07/22/2004 and the Action dated 02/03/2004.

Accordingly, no proper ground for reopening the prosecution here exists, and we submit that this alone constitutes a basis for the grating of this petition.

With respect now to [2], whether a proper procedure for reopening the prosecution was followed, MPEP 1208.02 provides the guidance “*The examiner may, with approval from the supervisory patent examiner, reopen prosecution to enter a new ground of rejection after appellant’s brief or reply brief has been filed*” and MPEP 1208.02 provides the further guidance “*The examiner must obtain supervisory approval in order to reopen prosecution after an appeal. See MPEP § 1002.02(d).* [SIC] (underlining added)”

In the present case, no indication appears that the Examiner had supervisory approval to reopen this prosecution and we doubt that the Examiner could have obtained supervisory approval here. In the alternative, if we are mistaken, we urge that such approval was very ill informed or ill considered, since such effectively endorses what we have shown above to be trivial, specious argumentation, intended to unduly delay this prosecution, and effectively thwart the spirit of the applicable statute, rules, and procedures under which the Office operates.

Accordingly, if the Examiner did not have supervisory approval to reopen this prosecution, we submit that this constitutes a second basis for the grating of this petition. In the alternative, if a supervisor of the Office did approve of this, we respectfully request that this clearly be stated for the record along with details about the identity of that supervisor and the date that they granted such approval.

Action requested (37 C.F.R. 1.181(b)):

Applicant respectfully requests that the Examiner be required to withdraw the Action purporting to reopen prosecution in this case, so that the Office credits this case appropriately for

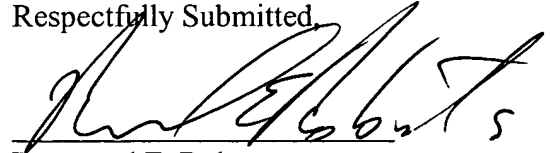
the purposes of patent term extension calculations and so that the Office now handles the remaining prosecution in the case in an appropriately expeditious manner.

Furthermore, in view of the reason necessitating this petition being at least one improper action on the part of the Examiner, Applicant respectfully requests that the payment for this petition be refunded.

Intellectual Property Law Offices
1901 S. Bascom Ave., Suite 660
Campbell, CA 95008

Telephone: 408.558.9950
Facsimile: 408.558.9960
E-mail: RRoberts@iplo.com

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'R. E. Roberts', written over a horizontal line.

Raymond E. Roberts
Reg. No.: 38,597

APPENDIX

4.3. Claims 1-15 and 23-36 are rejected under 35 U.S.C. § 102(b) as being anticipated by Baru et al (Hereafter, Baru), “The SDSC Storage Resource Broker”, ACM, 1998.

Regarding claim 1, Baru teaches a system for authenticating a subject residing in a subject domain on a network to a server application residing in a server domain on the network, wherein an authentication mechanism residing in an authentication domain on the network affects the service provided by the server application, the system comprising:

a client for communicating with other components of the system and for authenticating the subject to other components of the system by providing client credentials on behalf of the subject (= ticket mechanism) [see Sec. 2.5 on Page 3], wherein said client also resides in the subject domain (~~i.e.,~~ = client communicates with other components like SRB server for authentication) [see Fig. 2 and Sec. 3 on Page 5]; and

a protocol proxy (= Storage Resource Broker (SRB) middleware) [see Sec. 3 on Page 5] for communicating between said client and the authentication mechanism and for authenticating said client based on said client credentials, for obtaining from the authentication mechanism temporary credentials for said client to access the server application, and for creating from said temporary credentials an authentication name assertion allowing said client to access the server application (~~i.e.,~~ = proxy operations for communication between client and SRB agent as authentication mechanism) [see Secs. 2.8-2.10 on Page 4 and Sec. 3 on Page 5].

Regarding claim 2, Baru further teaches ~~the system of claim 1, wherein~~ the subject is non-human and said client is integrated into the subject, and said client gathers subject credentials for the subject and communicates said subject credentials to said protocol proxy [see Sec. 2.10 on Page 4 and Sec. 3 on Page 5]

Regarding claim 3, Baru further teaches ~~the system of claim 1, wherein~~ a plurality of the authentication mechanisms are present on the network, and the system further comprising an agent for communicating with other components of the system and for interacting with said client to chose an appropriate authentication mechanism from among said plurality of the authentication mechanisms, wherein said agent resides in an agent domain on the network [see Fig. 2].

Regarding claims 4-7, Baru further teaches the ~~system of claim 3, wherein said client~~ interacts with said protocol proxy to determine a specification of the authentication mechanism and said client communicates said specification to said agent and wherein said client includes a callback mechanism for determining said appropriate authentication mechanism for the server application from among said plurality of the authentication mechanisms and wherein said callback mechanism interacts with the subject to determine said appropriate authentication mechanism and wherein said callback mechanism accesses a configuration repository to determine said appropriate authentication mechanism [see Sec. 3 on Page 5].

Regarding claim 8, Baru further teaches the ~~system of claim 3, wherein said agent~~ includes a mechanism resolver for determining from said plurality of the authentication mechanisms a subset of zero or more of the authentication mechanisms which affects the service provided by the server application [see Fig. 2 and Sec. 3 on Page 5].

Regarding claim 9, Baru further teaches the ~~system of claim 8, wherein said agent~~ further includes an authentication agent for brokering between said client and said mechanism resolver [see Fig. 2].

Regarding claim 10, Baru further teaches the ~~system of claim 8, wherein said agent~~ further includes a mechanism repository for storing information about said plurality of the authentication mechanisms and said mechanism resolver queries said mechanism repository when determining said subset of zero or more of the authentication mechanisms which affects the service provided by the server application [see Sec. 3.1 on Page 5 and Page 6].

Regarding claims 11-12, Baru further teaches the ~~system of claim 10, wherein said agent~~ further includes a mechanism registrator for the authentication mechanism to register in said mechanism repository by adding information about itself and wherein said mechanism registrator is further for the authentication mechanism to update itself in said mechanism repository by changing information about itself [see Sec. 2.5 on Page 3]

Regarding claims 13-14, Baru further teaches said protocol proxy resides in said agent domain on the network or in the authentication domain on the network [see Fig. 2 and Sec. 2.8 on Page 4].

Regarding claim 15, Baru further teaches the system of claim 1, wherein said protocol proxy uses a standard security protocol to communicate with said client and a mechanism-specific protocol to communicate with the authentication mechanism [see Sec. 2.10 on Page 4 and Secs. 3-3.1 on pages 5 and 6]

Claim 23 is rejected under the same rationale set forth above to claim 1.

Claims 24-33 are rejected under the same rationale set forth above to claims 2-11, respectively.

Claims 34-36 are rejected under the same rationale set forth above to claims 13-15, respectively.

...

~~6-5.~~ Claims 17 and 37 are rejected under 35 U.S.C 103(a) as being unpatentable over Baru et al (Hereafter, Baru), "The SDSC storage Resource Broker", ACM, 1998 in view of admitted prior art (APA).

Regarding claim 17, Baru does not explicitly teach ~~the system of claim 1, wherein~~ at least one of said client and said protocol proxy authenticates using SRP protocol. However, ~~the use of SRP protocol is well known in the art as disclosed by APA, in the same field of federated authentication endeavor, discloses the use of SRP protocol~~ [see the Instant Application on Pages 1 and 2]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to ~~implement~~ incorporate the use of SRP protocol because it would have ~~provided~~ enabled a process for authenticating clients to the remote servers in a more secure fashion.

Claim 37 is rejected under the same rationale set forth above to claim 17.

~~7-6.~~ Claims 18-22 and 38-42 are rejected under 35 U.S.C 103(a) as being unpatentable over Baru et al (Hereafter, Baru), "The SDSC Storage Resource Broker", ACM, 1998 in view of Hele et al (Hereafter, Hele), U.S. Pat. Application Pub. No. US 2002/0120474.

Regarding claim 18-22, Baru does not explicitly teach protocol proxy produces a signed name assertion wherein said signed name assertion is contained in a S2ML document and wherein said protocol proxy further produces a signed name entitlement and wherein said protocol proxy uses a proxy name assertion to authenticate itself to the client and there is an adapter for receiving said authentication name assertion, recreating said credentials, and permitting said client to access the server application based on said credentials. However, ~~the use of XML adapter for authentication purpose is well known in the art as disclosed by Hele, in the same field of authentication endeavor, discloses the use of XML adapter for authentication purpose~~ [see Paragraph 0054]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to ~~implement~~ incorporate XML adapter because it would have provided a more secure way for the client to access the server application.

Claims 38-42 are rejected under the same rationale set forth above to claims 18-22.

Response to Arguments

8. Applicant's arguments have been fully considered but they are not persuasive because of the following reasons:

~~In response to applicant's arguments, the law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it. See Colman v. Kimberly Clark Corp., 218 USPO 789.~~

Baru teaches a method and system for authenticating a subject residing in a subject domain on a network to a server application residing in a server domain on the network, wherein an authentication mechanism residing in an authentication domain on the network affects the service provided by the server application comprising a client for communicating with other components of the system and for authenticating the subject to other components of the system by providing client credentials on behalf of the subject (= ticket mechanism) [see Sec. 2.5 on Page 3], wherein said client also resides in the subject domain. For example, client communicates with other components like SRB server for authentication [see Fig. 2 and Sec. 3 on Page 5]. *{Paragraph break added.}*

In addition, Baru further teaches a protocol proxy (= Storage Resource Broker (SRB) middleware) [see Sec. 3 on Page 5] for communicating between said client and the authentication mechanism and for authenticating said client based on said client credentials, for obtaining from the authentication mechanism temporary credentials for said client to access the server application, and for creating from said temporary credentials an authentication name assertion allowing said client to access the server application. For example, proxy operations for communication between client and SRB agent as authentication mechanism [see Secs. 2.8-2.10 on Page 4 and Sec. 3 on Page 5].

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a communication path shaped like the letter 'T' rotated 90 degrees counter clockwise as shown in Fig. 1 of the instant application and linear communication path "Client — Protocol Proxy — Authentication Mechanism — Protocol Client" as shown in claim 1) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

From the claim language point of view [see claim 1], there is no way triangle or "T" shaped rotated 90 degrees counter clockwise can be drawn to illustrate chronological step-by-step carried out for communication among components of client-server network as argued by applicants. Furthermore, one cannot determine based on the language of claim 1 limitations to obtain the linear communication path (Client — Protocol Proxy — Authentication Mechanism — Protocol Client) as argued by applicants.

Therefore, the examiner asserts that the cited prior arts teach or suggest the subject matter broadly recited in independent claims. Claims 2-22 and 24-42 are rejected at least by virtue of their dependency on independent claims and by other reasons set forth above. Accordingly, rejections to claims 1-42 are respectfully maintained as shown above.

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[appendix ends here]